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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

PD-980142

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name \_\_\_\_\_

Application Number

09492725

Filed

2000-01-27

First Named Inventor

Robert G. Arsenault

Art Unit

3688

Examiner

JANVIER, Jean D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 41320

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Todd N. Snyder

Typed or printed name

310-964-0560

Telephone number

2009-07-06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.


☐

\*Total of \_\_\_\_\_ forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants	:	ARSENAULT et al.	)	<u>Certificate of Transmission under 37 CFR 1.8</u>
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U.S. Serial No.	:	09/492,725	)	I hereby certify that this paper (and/or fee) is
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Filed	:	January 27, 2000	)	and Trademark Office via the Office
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			)	
Title	:	"System and Method for	)	
		Transmitting, Receiving and	)	
		Displaying Advertisements"	)	
			)	Janet Shibata
			)	
Art Unit	:	3688	)	
			)	
			)	
Examiner	:	Jean D. Janvier	)	

**PRE-APPEAL BRIEF**

Mail Stop AF  
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Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program, the Applicants submit this Pre-Appeal Brief accompanying a Pre-Appeal Brief Request for Review and a Notice of Appeal. Please consider the following.

**I. Status of the Claims**

Claims 18-34 and 41-67 stand rejected and form the subject of this pre-appeal brief. Claims 1-17 and 35-40 have been canceled.

**II. Issue on Appeal**

The issue on appeal is whether claims 18-23, 24, 32-34, 41-47, 56, 62, 64, and 67 are patentable over Gerace (WO 97/41673) in view of Official Notice and whether claims 18-34 and 41-67 are patentable over Hite et al. (US 5,774,170) in view of Official Notice.

### **III. Argument**

The Applicants respectfully submit that the Official Notice has not been properly made or maintained. In addition, the Applicants respectfully submit that neither Gerace in view of the Official Notice nor Hite et al. in view of the Official Notice render claims 18-34 and 41-67 *prima facie* obvious.

#### **A. The Official Notice Has Been Improperly Maintained**

The Applicants respectfully submit that absent the required supporting documentary evidence, the Official Notice has been improperly maintained. The Applicants incorporate by reference their remarks presented in the response to the final Office action filed on April 30, 2009, regarding the impropreress of the Official Notice. In particular, the Applicants respectfully renew their traversal of the Examiner's assertion of Official Notice and submit that at the time of the invention, it was not well known to transmit a plurality of image objects corresponding to an advertisement object to a receiver and select one of the plurality of image objects from the transmitted plurality of image objects while discarding the remaining image objects based on a processing capability of the receiver. *Applicants' Response filed April 30, 2009*, pp. 15 and 16. The deficiency in the Official Notice as pointed out in the Applicants' previous response is that transmitting objects as recited in, for example, claim 18, would have been contrary to the practice of preserving limited bandwidth. *Id.* Further, the teachings of the applied art are contrary to the Official Notice. *Id.* No other documentary evidence has been provided to support the Official Notice as required. *See MPEP 2144.03 (C).*

The Applicants recognize that personal computer technology was available well before March 29, 1999, the effective filing date of this application. However, the mere availability of personal computer technology does not necessarily mean that it was known to transmit a plurality of image objects corresponding to an advertisement object to a receiver and select one of the plurality of image objects from the transmitted plurality of image objects while discarding the remaining image objects based on a processing capability of the receiver. In addition, the mere assertion of personal computer technology being well known cannot properly support the Official Notice. Thus, the Applicants renew their request for the appropriate supporting documentary evidence or withdrawal of the Official Notice and the rejections relying thereon.

## **B. Independent Claim 18**

Independent claim 18 is directed to a system to display digital advertisement information that includes, *inter alia*, a receiver for use at a subscriber site, a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing capability to be rendered by the receiver. In addition, claim 18 recites that a link is used to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver.

Without conceding the properness of the Official Notice, the Applicants respectfully submit that it was not common practice at the time of the invention to receive at a subscriber site, a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing capability to be rendered by the receiver. Nor was it common practice to use a link to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver.

In the proffered Official Notice, it is suggested that it was common practice for an audio and video signal (audio/visual signal) to be broadcast over a network to a plurality of receivers such as TV and radio receivers, wherein some of the radio receivers are configured to play/display audio/visual signals, while others are adapted to play only audio signals. *Final Office Action dated March 4, 2009*, pp. 15, 16, 27, and 28; *Advisory Action*, p. 2. It is further suggested that upon receiving a transmitted audio and video file or signal, a radio receiver, capable of playing only an audio signal, will select the (audio) format that it supports for playing, while ignoring the video format or component of the file. *Id.*

In contrast to the above-noted TV/radio signal broadcast scenario, claim 18 involves receiving a plurality of image objects (each requiring a different processing capability to be rendered by a receiver), selecting one of the image objects, and discarding the remaining image objects based on the processing capability of the receiver. The TV broadcast signal referred to in the Official Notice includes only one type of image (i.e., a video signal) requiring a single type of processing capability. Further, even if a radio receiver were to ignore a video portion of a TV broadcast signal, the radio receiver would ignore the entire video signal without selecting any single image for display unlike claim 18, which involves selecting “one of the plurality of image objects.”

Also by way of the Official Notice, it is suggested that it is well understood in the art of computer technology that when one or more files, having a certain format, are transmitted to a receiver, the receiver is configured to recognize and successfully play or display a file if and only if the file is compatible with the receiver; otherwise, the file will not be played or displayed by the receiver or an error message will be played or displayed thereon. *Id.* On the contrary, documentary evidence of record (Gerace and Hite et al.) suggests the opposite. That is, as the Applicants previously submitted, Gerace and Hite et al. describe transmitting only image information that can be processed by a receiving entity. *Applicants' Response filed April 30, 2009*, p. 16. Thus, neither Gerace nor Hite et al. suggest not playing or displaying a received file, much less receiving for use at a subscriber site a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing capability to be rendered by the receiver and selecting one of the plurality of image objects and discarding the remaining plurality of image objects based on a processing capability of the receiver. No other documentary evidence has been provided to suggest that such a mode of operation otherwise existed at the time of the invention.

In view of the foregoing, the Applicants respectfully submit that the proffered Official Notice, even if appropriately maintained with supporting documentary evidence, does not teach or suggest a receiver for use at a subscriber site and a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing capability to be rendered by the receiver. Nor does the proffered Official Notice teach or suggest a link used to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver. Accordingly, the Applicants respectfully submit that independent claim 18 and all claims dependent thereon have been improperly rejected.

### **C. Independent Claims 24, 41, 48, and 56**

The Applicants respectfully submit that independent claims 24, 41, 48, and 56 have also been improperly rejected for at least the reasons discussed above in connection with claim 18.

**D. Conclusion**

In view of the foregoing, the Applicants respectfully submit that independent claims 18, 24, 41, 48, and 56 and all claims dependent thereon have been improperly rejected. Accordingly, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 and respectfully submit that independent claims 18, 24, 41, 48, and 56 and all claims dependent thereon are in condition for allowance. Reconsideration of this application is respectfully requested.

Should any fees be associated with this submission, please charge Deposit Account 50-0383.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Todd N. Snyder", is written over a horizontal line.

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Dated: July 6, 2009

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